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Appl. No. 10/754,302
Reply Dated May, 2006
Reply to Office Action Dated November 4th, 2005

REMARKS/ARGUMENTS

Reconsideration of the application is requested in view of the following remarks. Claims 1 to 24 remain pending in the application. We thank the examiner for indicating that claims 1 to 6 are allowable and request reconsideration of claims 7 to 24 in light of the following remarks.

Rejection under 35 U.S.C § 102(e)

Claims 7-9, 11-14, 19 and 20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Chen et al 6,877,570. This rejection is respectfully traversed.

The claims at issue each recite limitations not taught by any of the references of record. Chen fails to disclose, the limitation in the pending claims namely: "the mud motor configured to rotate the first cutter device in a direction opposite any rotation of the casing string, the second cutter device configured to rotate with the rotation of the casing string..."

In the currently claimed invention, the under-reamer is coupled to the casing and motor stator which is rotated clockwise by the rig top-drive looking down-hole as indicated by arrow R1, whereas bit is coupled to motor rotor which is rotated the opposite direction of the casing rotation by mud flow from the rig pumps past the rotor of motor or turbo-drill imparting a counter clockwise rotation as shown by arrow R2. The principle of opposite rotation of bit and under-reamer in our application is the key concept of this vertical drilling method in the invention and is fundamentally different to that of Chen where the bit and under-reamer are both coupled to the motor rotor shaft and turn in the same direction. Moreover, Chen utilizes bent sub for directional drilling where our claims for this method intend to hold vertical using the counter-rotating principles as discussed.

Appl. No. 10/754,302
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Applicant, therefore, submits that Chen fails to anticipate the currently claimed invention under 35 U.S.C. § 102 in that the current claims provide a limitation not taught by Chen.

Claims 7-14, 18-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Moriarty et al 2005/0126826. This rejection is respectfully traversed.

The cited application has a common inventor with the present application, namely Keith Moriarty, and therefore any invention disclosed but not claimed in the reference was derived from the invention of this application and is thus not the invention of "another."

Double Patenting

Claims 7 -24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1 -13 of co-pending and co-owned application 10/735,323. Applicant herewith files a terminal disclaimer in compliance with 37 CFR 1.32(2c). We therefore ask that this rejection be re-considered and withdrawn.

Rejection(s) under 35 U.S.C § 103

Claims 10 and 15-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chen. Applicant respectfully traverses the rejection.

Applicant submits that the Office Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 for any of the claims at issue. As described above with respect to the 102(b) rejection, none of the cited references alone or in combination teach all of the limitations of the claims. The Examiner attempts to achieve Applicant's invention by using improper hindsight, selective dissection and destruction of the teachings of the cited reference.

As discussed above with respect to the 102(b) rejection above, Chen fails to disclose the limitation in the pending claims of, "the mud motor configured to rotate the first cutter device in

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a direction opposite any rotation of the casing string, the second cutter device configured to rotate with the rotation of the casing string..." In fact, Chen teaches away from such a feature by providing that the bit and under-reamer are both coupled to the motor rotor shaft and therefore must turn in the same direction as they are fixed in position. Moreover, one skilled in the art would not seek to modify Chen as the entire disclosure is directed towards such a coupling. The modifications would require a re-think of the concept behind the design bent sub for directional drilling where our claims for this method intend to hold vertical using the counter-rotating principles as discussed.

Applicant also points out the differences between the pending claims and Chen referred to in the preceding paragraph. Applicant respectfully submits that it would not be obvious to one of ordinary skill to modify Chen, as Chen requires the bit and under-reamer are both coupled to the motor rotor shaft and thus must rotate in the same direction.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below.

Date: 3-may-06

Respectfully submitted,


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May 3, 2006 [Signature]
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/754,302 Confirmation No.: 8313

Applicant: Keith Alan Moriarty

Filed: January 9th 2004

TC/A.U. 3672

Examiner: Nueder, William P.

Docket No.: 19.0321 US

Customer No.:

Title: METHODS OF CASING DRILING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR EXTENSION OF TIME TO RESPOND AND
RESPONSE TO OFFICE ACTION DATED NOVEMBER 4, 2005**

Sir:

This is in response to the Office Action dated November 4th 2005, for which the three-month date for response is February 4th, 2006. A request for a three (3) month extension of the time to respond to the Official Action is hereby made, bringing the date for response to May 4th 2006. Please apply any charges not covered, such as the three-month extension fee, or any credits, to Deposit Account 50-2898 (Reference Number 19.0321).

Remarks/Arguments begin on page 2 of this paper.

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